

**REMARKS**

Applicants acknowledge the Examiner's statement that claims 56-59, 63-65 and 70-72 are allowable.

Applicants cancel claims 43-55, 60-62 and 66-69 without prejudice to the filing of another application directed to the subject matter therein.

**Rejections under 35 U.S.C. 132(a) and 35 U.S.C. 112, first paragraph**

In the Office Action dated July 12, 2005 the amendments filed December 8, 2003 are rejected under 35 U.S.C. 132(a) for adding new matter not supported by the original disclosure, i.e., the deletion of the relationship between Tg and R. The added new matter rejection is used as the basis for a 35 U.S.C. 112, first paragraph rejection of claims 43-55, 60-64 and 66-69. Applicants traverse the rejections for the reasons given in detail below.

The 35 U.S.C. 132(a) rejection is dependent upon a putative "required relationship between Tg and R." Although some embodiments of Applicants' invention have a relationship between Tg and R as disclosed in the equation in paragraph [0038] of the instant application, Applicants have expressly stated in paragraph [0039] of the instant application that other embodiments of Applicants' invention are not required to meet the equation in paragraph [0038].

"[0039] While the polyester film as described in the preceding paragraph is a preferred embodiment of the invention, it is not required that the film meet the equation as defined above. Alternatively, a biaxially oriented polyester film which is produced from a polyester as defined herein is provided, which does not necessarily have to meet the equation described in the previous paragraph, wherein said polyester film undergoes not more than 3% shrinkage when immersed for 10 seconds in a solder bath preheated to 260°C and exhibits a

coefficient of thermal expansion value of 10-85 ppm/°C, when  
measured between 120 and 150°C."  
(underlining added.)

On the basis of Applicants' disclosure in paragraph [0039], Applicants submit that the deletion of the relationship between T<sub>g</sub> and R in the claims filed in the Preliminary Amendment does not constitute new matter. Entry of the amended claims as filed in the Preliminary Amendment is proper. Applicants respectfully request withdrawal of the 35 U.S.C. 132(a) and 35 U.S.C. 112, first paragraph rejections.

### Rejection under 35 U.S.C. 103(c)

The 35 U.S.C. U.S.C. 103(c) rejection of claims 43-55, 60-62 and 66-69 is mooted by the cancellation of these claims.

### Conclusion

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), enter the above amendment, remove all rejections, and pass the application to issuance.

Respectfully submitted,

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#### CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Mail Stop Amendment, P. O. Box 1450, Alexandria, VA 22313-1450.

Karen L. Taylor  
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10/12/2005  
Date